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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,254	02/05/2004	Toshiyuki Okubo	1232-5278	8661
27123 7590 07/10/2007 MORGAN & FINNEGAN, L.L.P. 3 WORLD FINANCIAL CENTER NEW YORK, NY 10281-2101			EXAMINER JONES, HEATHER RAE	
			ART UNIT 2621	PAPER NUMBER
			MAIL DATE 07/10/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/774,254	Applicant(s) OKUBO, TOSHIYUKI	
	Examiner Heather R. Jones	Art Unit 2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 October 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/15/2004</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Specification***

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 8 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 8 defines a program embodying functional descriptive material. However, the claim does not define a computer-readable medium or memory and is thus non-statutory for that reason (i.e., "When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized" – Guidelines Annex IV).

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

Art Unit: 2621

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson (U.S. Patent 5,933,137) in view of Stam et al. (U.S. Patent 6,850,691).

Regarding claim 1, Anderson discloses an image reproduction apparatus comprising: a memory that stores a plurality of image files, each image file having a file structure that includes at least a high-resolution image and a low-resolution image, for the same image (Fig. 6); a display unit (402) that displays an image file of the plurality of image files stored in the memory; an operating unit operated by a user for forwarding an image displayed on the display unit (Fig. 5A); and a control unit that causes the display unit to successively display a low-resolution image of the plurality of image files at fast speed while the operating unit is in a predetermined operating state, and to display a high-resolution image on the display unit when the operating unit is released from the predetermined operating state (Fig. 11A; col. 13, lines 36-45). However Anderson fails to disclose displaying a high resolution image corresponding to a prior low-resolution image of a predetermined number of images prior to the low-resolution image displayed on the display unit when the operating unit is released from the predetermined operating state, without displaying the prior low-resolution image.

Referring to the Stam et al. reference, Stam et al. discloses an image reproduction apparatus wherein a control causes the display unit to successively display image files at a fast speed while the operating unit is in a predetermined

operating state, and to display a second image that is a predetermined number of images prior to the first image displayed on the display unit when the operating unit is released from the predetermined operating state, without displaying the prior images (col. 2, lines 2-9).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have corrected an overshoot when stopping the fast forwarding function as disclosed by Stam et al. with the apparatus disclosed by Anderson in order to accommodate for the user's reaction time, the time it takes for the user's command to be sent to the device along with the time it takes for the device to react, and to accommodate for the speed of the fast forward or reverse mode.

Regarding claim 2, Anderson in view of Stam et al. discloses all the limitations as previously discussed with respect to claim 1 including that the predetermined operating state is a state maintained continuously by the operating unit at a predetermined operating position for a predetermined time period (Anderson: Fig. 11A – the searching continues while the navigation button is held down).

Regarding claim 3, Anderson in view of Stam et al. discloses all the limitations as previously discussed with respect to claim 1 as well as disclosing an image reproduction apparatus further comprising a setting means for setting the predetermined number of images depending on the fast forward speed (Stam et al.: col. 2, lines 25-34).

Regarding claim 4, Anderson in view of Stam et al. discloses all the limitations as previously discussed with respect to claim 1 including that the predetermined number of images is set according to how the user operates the operating unit with respect to the fast forwarding display (Stam et al.: col. 2, lines 17-24 – the device adapts to the user by remembering how much the user corrects after they stop the fast forwarding mode).

Regarding claim 5, Anderson in view of Stam et al. discloses all the limitations as previously discussed with respect to claim 1 as well as disclosing an image reproduction apparatus further comprising a setting unit by which the user sets the predetermined number (Stam et al: col. 2, lines 35-46 – this device allows two ways for the user to set the predetermined number, one way is to take a test to figure out the user's reaction time and the other way to allow the user to simply set a sensitivity setting).

Regarding claim 6, Anderson in view of Stam et al. discloses all the limitations as previously discussed with respect to claim 1 including that the first image is fast forward displayed when the operating unit is not in the predetermined operating state (Anderson: Fig. 11A – the high resolution image is displayed when the navigation button is not being held down).

Regarding claim 7, this is a method claim corresponding to the apparatus claim 1. Therefore, claim 7 is analyzed and rejected as previously discussed with respect to claim 1.

Regarding claim 8, this is a computer program claim corresponding to the apparatus claim 1. Therefore, claim 8 is analyzed and rejected as previously discussed with respect to claim 1.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Heather R. Jones whose telephone number is 571-272-7368. The examiner can normally be reached on Mon. - Thurs.: 7:00 am - 4:30 pm, and every other Fri.: 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Heather R Jones

Application/Control Number: 10/774,254  
Art Unit: 2621

Page 7

Examiner  
Art Unit 2621

HRJ  
June 18, 2007



**JOHN MILLER**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 2600**